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EXAMINER
MURPHY, DILLON J

ART UNIT	PAPER NUMBER
2624	

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Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

Office Action Summary	Application No.	Applicant(s)
	09/970,702	TAKEI ET AL.
	Examiner	Art Unit
	Dillon J. Murphy	2624

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>05 October 2001</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-9</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-9</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All   b)☐ Some * c)☐ None of:

      1.☒ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>April 25, 2002</u>.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Specification

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 7, 8, and 9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The computer program claimed is merely a set of instructions per se. Since the computer program is merely a set of instructions not embodied on a computer readable medium to realize the computer program functionality, the claimed subject matter is not statutory. See MPEP § 2106 IV.B.1.

Claim Objections

Claims 1-9 are objected to because of the following informalities:

With regard to the independent claim 1, the portion reading "setting means for setting in the printer parameters for the finishing specifics separated by the sorting means and assigned to the printer" contains grammatical errors leading to possible confusion (page 18, lines 16-18). A possible change to the claim might be "setting

means for setting in the printer *the* parameters for the finishing specifics *as* separated

by the sorting means and assigned to the printer." The examiner will evaluate the claim

as best interpreted here.

With regard to the independent claim 4, the claim objection of claim 1 is

representative of claim 4. Claim 4 is objected to for having the same grammatical errors

(page 20, lines 8-10).

With regard to the independent claim 7, the portion reading "setting in the printer

parameters for the finishing specifics separated and assigned to the printer" contains

grammatical errors leading to possible confusion (page 21, lines 22 and 23). A possible

change to the claim might be "setting in the printer *the* parameters for the finishing

specifics *as* separated and assigned to the printer." The examiner will evaluate the

claim as best interpreted here.

Regarding claims 2, 3, 5, 6, 8, and 9, they inherit the deficiencies as dependent

claims of the independent claims 1, 4, and 7, respectively, and are objected to for the

stated minor informalities.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 4, 5, 7 and 8 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Hansen (U.S. 6,509,974 B1).

With regard to claim 1, Hansen teaches a printing system comprising an on-line client (Figure 1a, showing a Client PC in the Print Shop Client), print server (Figure 1b, showing print server #120), and printer (Figure 1b, showing a plurality of production print devices #122 including an XYZ Printer), as well as an off-line finishing device (Figure 1b, XYZ Off-line Finishing Device #122) wherein the print server includes:

First memory means (Figure 1b, computer hard drive of print server #120) for storing specifications of the printer and of the finishing device as well as information regarding options installed thereon (Workflow software is programmed with data about different production output devices, column 11, lines 26-33, stored in the job-prep workstation, column 8, lines 47-50, wherein the job-prep workstation is coupled with the print server, column 7, lines 11-13);

Receiving means for receiving from the client data pertaining to a job ticket that includes at least finish specifics for printing to be executed (jobs received by a print server contain "flags/attributes," column 18, lines 29-35, which specify production output device instructions and parameters, as well as other finishing steps which may or not be automated, column 11, lines 64-67 and column 12, lines 1 and 2);

Sorting means for, based on the information regarding the specifications and installed options that is stored in the first memory means, separating the finishing

specifics included in the job ticket received by the receiving means into those to be

performed by the printer and those to be performed by the finishing device (Hansen

teaches a print system wherein the print server directs the jobs to specific production

output devices based on attributes of print jobs and how attributes are satisfied by print

engine, column 7, lines 30-42);

Setting means for setting in the printer parameters for the finishing specifics

separated by the sorting means and assigned to the printer (prepared documents are

passed along with print tickets to production output devices, column 8, lines 34-42), and

Creating means for creating data for a finishing device job ticket that includes the

finishing specifics separated by the sorting means and assigned to the finishing device

(Workflow management software includes means for creation and manipulation of job

tickets and printing, column 9, lines 20-28).

With regard to claim 2, which depends from claim 1, Hansen further teaches a

printing system wherein the print server further includes transmitting means for

transmitting to the printer the data pertaining to the finishing device job ticket created by

the creating means so as to print the finishing device job ticket (ticket may be either

electronic or hard copy, column 4, lines 46-52, and tickets are sent to production output

devices for final production, column 12, lines 31-33).

With regard to claim 4, Hansen teaches a print server to be used in a printing

system including an on-line client (Figure 1a, showing a Client PC in the Print Shop

Client), print server (Figure 1b, showing print server #120), and printer (Figure 1b,

showing a plurality of production print devices #122 including an XYZ Printer), as well

as an off-line finishing device (Figure 1b, XYZ Off-line Finishing Device #122) the print

server comprising:

First memory means (Figure 1b, computer hard drive of print server #120)

workflow software is programmed with data about different production output devices

(column 11, lines 26-33))) for storing specifications of the printer and of the finishing

device as well as information regarding options installed thereon (Workflow software is

programmed with data about different production output devices, column 11, lines 26-

33, stored in the job-prep workstation, column 8, lines 47-50, wherein the job-prep

workstation is coupled with the print server, column 7, lines 11-13);

Receiving means for receiving from the client data pertaining to a job ticket that

includes at least finish specifics for printing to be executed (jobs received by a print

server contain "flags/attributes," column 18, lines 29-35, which specify production output

device instructions and parameters, as well as other finishing steps which may or not be

automated, column 11, lines 64-67 and column 12, lines 1 and 2);

Sorting means for, based on the information regarding the specifications and

installed options that is stored in the first memory means, separating the finishing

specifics included in the job ticket received by the receiving means into those to be

performed by the printer and those to be performed by the finishing device (directing the

jobs to specific production output devices based on attributes of print jobs and how

attributes are satisfied by print engine, column 7, lines 30-42);

Setting means for setting in the printer parameters for the finishing specifics

separated by the sorting means and assigned to the printer (prepared documents are

passed along with print tickets to production output devices, column 8, lines 34-42); and

Creating means for creating data for a finishing device job ticket that includes the

finishing specifics separated by the sorting means and assigned to the finishing device

(Workflow management software includes means for creation and manipulation of job

tickets and printing, column 9, lines 20-28).

With regard to claim 5, which depends from claim 4, Hansen further teaches:

A print server, further comprising transmitting means for transmitting to the

printer the data pertaining to the finishing device job ticket created by the creating

means so as to print the finishing device job ticket [ticket may be either electronic or

hard copy (column 4, lines 46-52), and tickets are sent to production output devices for

final production, column 12, lines 31-33).

With regard to claim 7, Hansen teaches a computer program (computer program,

column 8, lines 47-58 and column 7, lines 20-24) in a computer readable medium to be

used in a printing system which includes an on-line client (Figure 1a showing in the Print

Shop Client a Client PC) and printer (Figure 1b, XYZ Printer #122) as well as an off-line

finishing device (Figure 1b, XYZ Off-line Finishing Device #122), and which executes a

print job based on a job ticket including at least finishing specifics for printing to be

executed (column 2, lines 43 and 44), the computer program cause a computer execute

processing comprising the steps of:

Receiving the job ticket from the client (receiving information from scanner or a

program on a client computer in various formats, column 9, lines 29-39);

Separating the finishing specifics included in the received job ticket into those to

be performed by the printer and those to be performed by the finishing device, based on

information regarding specifications and installed options of the printer and finishing

device that is stored in first memory means (directing the jobs to specific production

output devices based on attributes of print jobs and how attributes are satisfied by print

engine, column 7, lines 30-42);

Setting in the printer parameters for the finishing specifics separated and

assigned to the printer (prepared documents are passed along with print tickets to

production output devices, column 8, lines 34-42); and

Creating data for a finishing device job ticket that includes the finishing specifics

separated and assigned to the finishing device (Workflow management software

includes means for creation and manipulation of job tickets and printing, column 9, lines

20-28).

With regard to claim 8, which depends from claim 7, Hansen further teaches that

the processing further comprises a step of transmitting to the printer the created data

pertaining to the finishing device job ticket so as to print the finishing device job ticket

(ticket may be either electronic or hard copy, column 4, lines 46-52, and tickets are sent

to production output devise for final production, column 12, lines 31-33).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set
forth in section 102 of this title, if the differences between the subject matter sought to be patented and
the prior art are such that the subject matter as a whole would have been obvious at the time the
invention was made to a person having ordinary skill in the art to which said subject matter pertains.
Patentability shall not be negatived by the manner in which the invention was made.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hansen

(U.S. 6,509,974 B1) as applied to claim 2 above, and further in view of Rourke (U.S.

4,970,554) and Jeyachandran el al. (U.S. 6,567,176 B1).

Regarding claim 3, which depends from claim 2, Hansen teaches a first memory

means, a receiving means, a sorting means, a setting means, a creating means, and a

transmitting means, as discussed above, while also teaching an on-line scanner (Figure

1a, #116) to be used in a printing system (Figure 1a and 1b, #112). Furthermore,

Hansen also teaches a second memory means for storing job information and user

information included in the job ticket received by the receiving means (Hansen saves

documents and all of the associated tickets, column 12, lines 24-26. Saving occurs on

print server #116, Document Library #114, and on computer workstation #114 of Figure

1a.). Hansen does not teach a reading. However, Rourke teaches a reading means for

reading the job information from the data obtained by reading via the scanner the

finishing device job ticket printed by the printer (Rourke scans the job tickets to identify

the job numbers associated with specific documents, column 4, lines 38-48).

Hansen and Rourke are combinable because they are in the same field of

endeavor of print job processing and printing. At the time of the invention, it would have

been obvious to a person of ordinary skill in the art to add the reading means of Rourke

to the first memory means, receiving means, sorting means, setting means, creating

means, transmitting means, and on-line scanner of Hansen. The motivation for doing

so would have been to decrease the number of manual steps of job preparation the

operator must normally encounter (Hansen, column 19, lines 62-64), provide direction to

operators and allow them to efficiently manage the jobs through job tickets (Rourke,

column 1, lines 26-36).

The combination of Hansen and Rourke does not teach a notifying means.

However, Jeyachandran teaches a notifying means for calling the user information

stored in the second memory means based on the job information read by the reading

means and notifying the client of job completion based on the user information (scanner

reads in job and job information, transmits data to printer to be printed, and once

printing is completed, notifies user that instructed job was performed based on

information stored in memory, column 21, lines 7-15 and column 20, lines 46-52).

Hansen, Rourke, and Jeyachandran are combinable because they are all in the

same field of endeavor of network printing and finishing. At the time of the invention, it

would have been obvious to a person of ordinary skill in the art to add the notifying

means of Jeyachandran to the combination of Hansen and Rourke comprising of first

memory means, receiving means, sorting means, setting means, creating means,

transmitting means, reading means, and on-line scanner. The motivation for doing so

would have been to decrease the number of manual steps of job preparation the

operator must normally encounter (Hansen, column 19, lines 62-64), to provide direction

to operators and allow them to efficiently manage the jobs through job tickets (Rourke,

column 1, lines 26-36), to allow an external device to acquire and output information to

be processed (Jeyachandran, column 2, lines 57-61), and to provide a printing

apparatus that can perform printing by employing appropriate printing parameters

consonant with the processing objective, without a complex operation being required

(Jeyachandran, column 2, lines 38-42). Therefore, it would have been obvious to

combine Hansen with Rourke and Jeyachandran to obtain the invention as specified in

claim 3.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hansen

(U.S. 6,509,974 B1) as applied to claim 5 above, and further in view of Rourke (U.S.

4,970,554) and Jeyachandran el al. (U.S. 6,567,176 B1).

Regarding claim 6, which depends from claim 5, Hansen teaches a first memory

means, a receiving means, a sorting means, a setting means, a creating means, and a

transmitting means, as discussed above, while also teaching an print server (Figure 1b,

#120) (to be used in a printing system) wherein the printing system further includes an

on-line scanner (Figure 1b, #116). Furthermore, Hansen also teaches a second

memory means for storing job information and user information included in the job ticket

received by the receiving means (Hansen saves documents and all of the associated

tickets, column 12, lines 24-26. Saving occurs on print server #116, Document Library

#114, and on computer workstation #114 of Figure 1a.). Hansen does not teach a

reading means or a notifying means. However, Rourke teaches a reading means for

reading the job information from the data obtained by reading via the scanner the

finishing device job ticket printed by the printer (Rourke scans the job tickets to identify

the job numbers associated with specific documents, column 4, lines 38-48).

Hansen and Rourke are combinable because they are in the same field of

endeavor of print job processing and printing. At the time of the invention, it would have

been obvious to a person of ordinary skill in the art to add the reading means of Rourke

to the first memory means, receiving means, sorting means, setting means, creating

means, transmitting means, and on-line scanner of Hansen. The motivation for doing

so would have been to decrease the number of manual steps of job preparation the

operator must normally encounter (Hansen, column 19, lines 62-64), provide direction to

operators and allow them to efficiently manage the jobs through job tickets (Rourke,

column 1, lines 26-36).

The combination of Hansen and Rourke does not teach a notifying means.

However, Jeyachandran teaches a notifying means for calling the user information

stored in the second memory means based on the job information read by the reading

means and notifying the client of job completion based on the user information (scanner

reads in job and job information, transmits data to printer to be printed, and once

printing is completed, notifies user that instructed job was performed based on

information stored in memory, column 21, lines 7-15 and column 20, lines 46-52).

Hansen, Rourke, and Jeyachandran are combinable because they are all in the

same field of endeavor of network printing and finishing. At the time of the invention, it

would have been obvious to a person of ordinary skill in the art to add the notifying

means of Jeyachandran to the combination of Hansen and Rourke comprising of first

memory means, receiving means, sorting means, setting means, creating means,

transmitting means, reading means, and on-line scanner. The motivation for doing so

would have been to decrease the number of manual steps of job preparation the

operator must normally encounter (Hansen, column 19, lines 62-64), to provide direction

to operators and allow them to efficiently manage the jobs through job tickets (Rourke,

column 1, lines 26-36), to allow an external device to acquire and output information to

be processed (Jeyachandran, column 2, lines 57-61), and to provide a printing

apparatus that can perform printing by employing appropriate printing parameters

consonant with the processing objective, without a complex operation being required

(Jeyachandran, column 2, lines 38-42). Therefore, it would have been obvious to

combine Hansen with Rourke and Jeyachandran to obtain the invention as specified in

claim 6.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hansen

(U.S. 6,509,974 B1) as applied to claim 8 above, and further in view of Rourke (U.S.

4,970,554) and Jeyachandran el al. (U.S. 6,567,176 B1).

Regarding claim 9, which depends from claim 8, Hansen teaches a computer

program recorded in a computer-readable recording medium capable of receiving,

separating, setting, creating, and transmitting, as discussed above, while also teaching

an on-line scanner (Figure 1a, #116) to be used in a printing system (Figures 1a and 1b,

#112). Furthermore, Hansen also teaches that the processing further comprises the

steps of storing job information and user information included in the receiving job ticket

into second memory means (Hansen saves documents and all of the associated tickets,

column 12, lines 40-42. Saving occurs on print server #116, Document Library #114, and on computer workstation #114 of Figure 1a.). Hansen does not disclose reading the job information from the data obtained by reading the finishing device job ticket printed by the printer. However, Rourke teaches of reading the job information from the data obtained by reading the finishing device job ticket printed by the printer (Rourke scans the job tickets to identify the job numbers associated with specific documents, column 4, lines 38-48. Processing also occurs on a computer in an electronic job program file, column 3, lines 53-56).

Hansen and Rourke are combinable because they are in the same field of endeavor of print job processing and printing. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to add the reading means of Rourke to the receiving means, separating means, setting means, creating means, transmitting means, storing means, and on-line scanner of Hansen. The motivation for doing so would have been to use a computer program on a computer readable medium to decrease the number of manual steps of job preparation the operator must normally encounter (Hansen, column 19, lines 62-64), provide direction to operators and allow them to efficiently manage the jobs through job tickets (Rourke, column 1, lines 26-36).

The combination of Hansen and Rourke does not teach a computer program on a computer readable medium comprising the steps of calling the user information and notifying the client. However, Jeyachandran teaches a the processing steps which comprises of calling the user information stored in the second memory means based on the read job information and notifying the client of job completion based on the user

information (operating as a program on a computer, scanner reads in job and job

information, transmits data to printer to be printed, and once printing is completed,

notifies user that instructed job was performed based on information stored in memory,

column 21, lines 7-15 and column 20, lines 46-52, Figure 16a).

Hansen, Rourke, and Jeyachandran are combinable because they are all in the

same field of endeavor of network printing and finishing. At the time of the invention, it

would have been obvious to a person of ordinary skill in the art to add the notifying

means of Jeyachandran to the combination of Hansen and Rourke comprising of a

computer program on a computer readable medium of first memory means, receiving

means, sorting means, setting means, creating means, transmitting means, reading

means, and on-line scanner. The motivation for doing so would have been to decrease

the number of manual steps of job preparation the operator must normally encounter

(Hansen, column 19, lines 62-64), to provide direction to operators and allow them to

efficiently manage the jobs through job tickets (Rourke, column 1, lines 26-36), to allow

an external device to acquire and output information to be processed (Jeyachandran,

column 2, lines 57-61), and to provide a printing apparatus that can perform printing by

employing appropriate printing parameters consonant with the processing objective,

without a complex operation being required (Jeyachandran, column 2, lines 38-42).

Therefore, it would have been obvious to combine Hansen with Rourke and

Jeyachandran to obtain the invention as specified in claim 9.
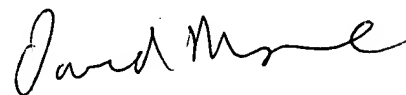
Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Hamilton, U.S. 5,715,381, filed August 8, 1994, teaches a printing system with job ticket control, scanning, memory, transmission, and a finishing device.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dillon J. Murphy whose telephone number is (571) 272-5945. The examiner can normally be reached on M-F, 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on (571) 272-7437. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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